REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 13-21 are pending in the application subsequent to entry of this Amendment.

The specification has been amended to up-date the status of the parent application as being abandoned. Applicants' claims are directed to a method for producing a two component polyurethane sealant. Claims 13-21 are rejected as being unpatentable over EP 0284015 in view of Nakamura et al ('034).

EP 0284015 discloses a polyurethane sealant composition comprising a blocked polyurethane prepolymer, an amine curing agent and an effective amount of a bicyclic amide catalyst or a derivative thereof. The curing agent has at least two primary amine groups (*see* claim 1).

Thus, the polyurethane sealant composition of EP 0284015 serves as a sealant by curing the polyurethane prepolymer with the curing agent (page 3, line 54 to page 4, line 20). In addition, in EP 0284015, an effective amount of a bicyclic amidine catalyst or a derivative thereof is added to accelerate curing of the polyurethane prepolymer by the amine curing agent (*see* page 4, lines 21 to 28).

The present invention does not require an amine curing agent, which is essential to the polyurethane sealant composition of EP 0284015, and EP 0284015 does not suggest omission of an amine curing agent at all.

In item 4 of the Official Action it is acknowledged that the primary reference fails to specifically disclose the use of an unsaturated carboxylic acid corresponding to those used by applicants. To remedy this situation the examiner directs attention to the catalyst described in the Nakamura reference. Nakamura et al relates to production of a modified polyisocyanurate foam and is irrelevant to production of a two component polyurethane sealant.

Therefore, even if EP 0284015 and Nakamura et al were combined, the present invention is not anticipated by or obvious from the combination of EP 0284015 and Nakamura et al.

The mere fact the references can be modified or combined is not enough. As stated by the Court in *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-1784 (Fed. Cir. 1992)(emphasis added):

> The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.

Thus, the mere fact that references can be combined or modified (Applicants believe they cannot be) does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed.Cir. 1990); MPEP § 2143.01. Hence, the Examiner's attempt to combine the cited references alone without any suggestion in the references of the desirability of the modification is improper and should be withdrawn.

As discussed above, the polyurethane sealant composition of EP 0284015 requires that the polyurethane prepolymer is cured by an amine curing agent. Further, as to the bicyclic amidine catalyst, EP 0284015 merely discloses that "The reaction product with phenol is desired whereas the unreacted catalyst DBU is preferred" (page 4, lines 44-45) and only DBU is used in the Example in combination with a specific amine curing agent.

Therefore, with the teaching of EP 0284015, a person skilled in the art would not have arrived at the present invention.

Nakamura et al discloses the combined use of (a) a trimerization catalyst and (b) a carbodiimidation catalyst for the production of a modified polyisocyanurate foam and thus, never suggests single use of (a) the trimerization catalyst.

Nakamura et al mentions DBU salts with more than 70 acids for use as the trimerization catalyst (a) (column 5, lines 1-40) and disclose not only 7 specific phosphorene oxides for use as the carbodiimidation catalyst (b) but also various groups as

each substituent in the carbodiimidation catalyst (b) represented by the formula (II) or (III) (column 5, lines 57-64). Thus, Nakamura et al discloses numerous combinations of the trimerization catalyst (a) and the carbodiimidation catalyst (b). Even though Nakamura et al discloses crotonic acid as an example of the acid component of the trimerization catalyst (a), Nakamura et al never suggests single use of the DBU salt of crotonic acid without the carbodiimidation catalyst.

Therefore, with the teaching of Nakamura et al, a person skilled in the art would not have arrived at the present invention.

For the above reasons it is respectfully submitted that the claims of this application define inventive subject matter. Reconsideration and allowance are solicited.

Respectfully submitted,

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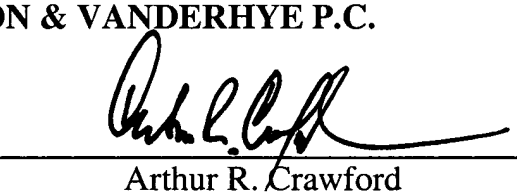
By: 

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